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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,651	02/29/2000	MASANORI KAMATA	P18896	2074
7055	7590	09/08/2005		
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER POON, KING Y	
			ART UNIT	PAPER NUMBER
			2624	
DATE MAILED: 09/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,651

Applicant(s)

KAMATA, MASANORI

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/5/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The amendment to the specification filed on 7/5/2005 has been accepted.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 35, 36, 44, 47, 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsunai (US 5,357,350).

Regarding claims 35, 44: Matsunai teaches an image recording apparatus (fig. 1) having a copy mode (STP1, fig. 4) and a facsimile mode (STP7, fig. 4), the image

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recording apparatus comprising; a panel section (column 5, line 18) which has input keys (column 5, line 11) operable to input a numerical value corresponding to at least one of a number of copies (column 6, lines 66-67, column 7, lines 1-2) in the copy mode and a telephone number of a destination in the facsimile mode (column 7, lines 3-10); a display section (18e, fig. 2A, 2B, column 5, lines 19-21) which selectively displays (STP 8, fig. 4, STP 34, fig. 5) one of a screen for the copy mode and a screen for the facsimile mode, a display capacity of the screen in the copy mode being smaller than a display capacity of the screen in the facsimile mode (STP 6, fig. 4); and a controller (PPC 2, column 6, lines 45-46) which, when the copy mode is set and when the numerical value input by the panel section exceeds the display capacity of the screen in the copy mode (STP 7 fig. 4), switches from the copy mode to the facsimile mode.

Regarding claim 36: Matsunai teaches wherein the display capacity of the screen, when the input numerical value corresponding to the number of copies is displayed, is smaller than the display capacity of screen, when the input numerical value the screen, when the input numerical value corresponding to the telephone number of the destination is displayed (STP 6, fig. 4).

Regarding claims 47, 48: Matsunai teaches wherein the controller is configured to switch to the facsimile mode in response to the numerical value exceeding the display capacity of the screen in the copy mode (STP 6, STP 7, fig. 4).

4. Claims 40, 46 rejected under 35 U.S.C. 102(e) as being anticipated by Kurozasa (US 5,940,188).

Regarding claims 40, 46: Kurozasa teaches an image recording apparatus (fig. 1) having a copy mode and a facsimile mode (98a, 98b, fig. 2), the image recording apparatus comprising: a panel section (fig. 2) which has input keys operable to input at least a numerical value corresponding to one of the number of copies in the copy mode (92, fig. 2) and a telephone number of a destination in the facsimile mode (column 7, lines 15-32); and a controller (column 8, lines 25-30) which determines, when the copy mode is set, whether or not an input by the panel section includes a predetermined character (application switching, fig. 2) and which switches from the copy mode to the facsimile mode (column 7, lines 27-32) when the input by the panel section includes the predetermined character not including a numerical value.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 37-39, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunai (US 5,357,350).

Regarding claim 37: Matsunai teaches an image recording apparatus (fig. 1) having a copy mode and a facsimile mode (fig. 4), the image recording apparatus

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comprising: a panel section (column 5, line 9) which has input keys (column 5, line 11) operable to input a numerical value corresponding to at least one of the a number of copies (STP 1, STP 5, fig. 4) in the copy mode and a telephone number (STP 8, fig. 4) of a destination in the facsimile mode, and which has a start key (18a, fig. 4) which starts at least one of copying and facsimile transmission; and a controller (PPC 2, column 6, lines 45-46) which determines (note) whether or not the numerical value (0-9, column 5, lines 10-13) input by the panel section is the numerical value corresponding to the number of copies when the copy mode is set, and which, when the numerical value input by the panel section is not the numerical value corresponding to the number copies (note) when the start key is actuated, maintains the copy mode (no of STP6, fig. 4) and inhibits a start of copying; the controller further being configured to wait (inherent properties when entering number one in a time, STP 5, fig. 4) for another input by the panel section in the copy mode when the controller inhibit copying.

Note: Matsunai, column 5, lines 10-15, teaches that the numeric key would allow user to enter numeric values from 0-9. Although Matsunai does not disclose what happen when user enter 0 in copy mode and press the start key, it would have been obvious to a person with ordinary skill in the art to know that the machine of Matsunai would not (inhibit) print any copies if a 0 is being entered because 0 indicates no copy is to be make, when the image recording apparatus is in copy mode.

Regarding claim 38: Matsunai teaches according to claim wherein the controller determines that the input numerical value corresponds to the number of copies by

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using, as a threshold value (STP 6, fig. 4) , a number of digits less than the number of digits utilized for the telephone number of the destination.

Regarding claim 39: Matsunai teaches wherein the another input by the panel section comprises an input of a reset key (clear, column 5, lines 15-20, return to initial state means reset).

Regarding claim 45: Matsunai teaches a method for controlling an image recording apparatus (fig. 1) having a copy mode and a facsimile mode (fig. 4), the image recording apparatus having a start key (STP 3, STP 10, fig. 4) which starts at least one of copying and facsimile transmission, the method comprising: inputting a numerical value corresponding to at least one of a number of copies (smaller than 5, STP 6, fig. 4) in the copy mode and a telephone number (reaches 5, STP 6, fig. 4) of a destination in the facsimile mode; determining whether or not the input numerical value is a numerical value corresponding to the number of copies when the copy mode is set (STP 6, fig. 4); inhibiting of the copying when the input numerical value is not the numerical value corresponding to the number of copies (according to fig. 4, the copy operation cannot be started even if start key is depressed when the number entered is not a copy number; note), even if the start key is actuated; and waiting for another input (inherent properties when entering number one in a time, STP 5, fig. 4) when copying is inhibited.

Note: Matsunai, column 5, lines 10-15, teaches that the numeric key would allow user to enter numeric values from 0-9. Although Matsunai does not disclose what happen when user enter 0 in copy mode and press the start key, it would have been

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obvious to a person with ordinary skill in the art to know that the machine of Matsunai would not (inhibit) print any copies if a 0 is being entered because 0 indicates no copy is to be made, when the image recording apparatus is in copy mode.

7. Claims 40, 42, 43, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunai (US 5,357,350) in view of Kurozasa (US 5,940,188).

Regarding claims 40, 46: Matsunai teaches an image recording apparatus (fig. 1) having a copy mode and a facsimile mode (fig. 4), the image recording apparatus comprising: a panel section (column 5, lines 9-10) which has input keys (column 5, line 11) operable to input at least a numerical value corresponding to one of the number of copies in the copy mode (before reaches 5, STP 6, fig. 4) and a telephone number of a destination in the facsimile mode (after reaches 5, STP 6, fig. 4); and a controller (PPC 2, column 6, lines 45-46) which determines, when the copy mode is set, whether or not an input by the panel section includes a condition and which switches from the copy mode to the facsimile mode when the input by the panel section includes the condition.

Matsunai does not teach the input includes a predetermined character which is not a numerical value that allowed the controller to detect to switch the image recording apparatus from the copy mode to the facsimile mode.

Kurozasa, in the same area of image recording apparatus design, teaches it is well known in the art that an fax/print apparatus includes input and the input includes a predetermined character (application switching, fig. 2, column 7, lines 28-32) which is

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not a numerical value that allowed the controller to detect to switch the image recording apparatus from the copy mode to the facsimile mode.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Matsunai to include: the input includes a predetermined character which is not a numerical value that allowed the controller to detect to switch the image recording apparatus from the copy mode to the facsimile mode.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Matsunai by the teaching of Kurozasa because of the following reasons: (a) it would have allowed the user to have more control over the image recording apparatus and would have provided user with clear instruction such that error would be reduced; and (b) offering more options for the user would allow the users to think that the machine is better in design, and willing to pay for the recording apparatus at a higher price.

Regarding claim 42: Matsunai teaches wherein when the controller switches from the copy mode to the facsimile mode, the numerical value input by the panel section is retained, the retained numerical value being utilized in the facsimile mode (STP 7, fig. 4).

Regarding claim 43: Matsunai teaches wherein the controller combines digits of a numerical value input by the panel section in the facsimile mode with digits of the retained numerical value (STP 7, fig. 4), after the controller switches from the copy mode to the facsimile mode, and calls the destination based on the telephone number

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including the retained numerical value (STP 12, fig. 4, in order to fax, the telephone (fax) number must be called).

8. Claims 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunai (US 5,357,350) in view of Kurozasa (US 5,940,188) as applied to claim 40 above, and further in view of Otsuka et al (US 6,307,646).

Regarding claim 41: Matsunai does not teach wherein the predetermined character comprises a pause.

Otsuka, in the same area of fax/printer apparatus design teaches it is well known in the art to user pause/redial character for a redial (fig. 2).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Matsunai to include: wherein the predetermined character comprises a pause/redial character for redial. (note: In Matsunai, dialing a phone number can occur only in fax mode)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Matsunai by the teaching of Otsuka because of the following reasons: (a) it would have allowed the user to have more control over the image recording apparatus and would have provided user with clear instruction such that error would be reduced; and (b) offering more options for the user would allow the users to think that the machine is better in design, and willing to pay for the recording apparatus at a higher price.

Response to Arguments

9. Applicant's arguments filed 7/5/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument "when the number of inputs by the keys 18b is 4 (less than the numeric limit (5) and more than the display capacity (3) of the display section 18e), the copy mode is not switched into the facsimile mode. In other words, the numeric limit (5) does not correspond to the display capacity (3) of the display section 18e in the copy mode, but rather corresponds to "numeric data, e.g., "5" which is difficult to be regarded as the number of copies or a magnification (col.6, lines 65-66)" has been considered.

In reply: Column 5, lines 2-20 clearly teaches display of a copy number, magnification number which is limited to 5, as disclosed in fig. 4, STP6-STP8. To the machine of Matsunai, the number 4 is a copy value and the machine would copy according to fig. 4. The examiner does not see where the display capacity is being set at 3 of Matsunai.

With respect to applicant's argument that Matsunai does not teach selectively display, has been considered.

In reply: STP 7, STP8, fig. 4, STP 33 and STP 34, fig. 4 Matsunai teaches selectively display.

With respect to applicant's argument that Matsunai does not teach threshold value for input digits in copy mode is related to how many digits the display screen is capable of displaying in the copy mode, has been considered.

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In reply: Column 6, lines 50-55, teaches threshold value for input digits in copy mode is related to how many digits being inputted. Fig. 4, STP 6-STP 8 teaches the threshold value is how many digits the display screen is capable of displaying in the copy mode.

With respect to applicant's argument that Matsunai does not teach when the numerical value input by the panel section is not the numerical value corresponding to the number copies and when the start key is actuated, maintains the copy mode and inhibits copying.

In reply: the examiner is interpreting the 0 value is not a value corresponding to the number copies because no rational people would like to make copies and instruct the copier to copy 0.

Matsunai, column 5, lines 10-15, teaches that the numeric key would allow user to enter numeric values from 0-9. Although Matsunai does not disclose what happen when user enter 0 in copy mode and press the start key, it would have been obvious to a person with ordinary skill in the art to know that the machine of Matsunai would not (inhibit) print any copies if a 0 is being entered because 0 indicates no copy is to be make, when the image recording apparatus is in copy mode.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

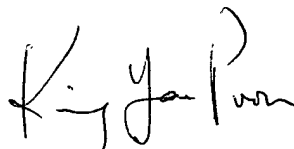
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 30, 2005

A handwritten signature in black ink, appearing to read "King Y. Poon". The signature is fluid and cursive, with the first name "King" and last name "Poon" clearly distinguishable.

KING Y. POON
PRIMARY EXAMINER